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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/724,631	10/01/96	MCCORMICK	M 700399.90053

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HM12/0217

EXAMINER

OWENS JR, H

ART UNIT	PAPER NUMBER
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1623

DATE MAILED:

02/17/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/724,631**

Applicant(s)  
**McCormick**

Examiner  
**Howard Owens**

Group Art Unit  
**1623**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-13 and 16-24 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 4-6, 9, 13, and 16-24 is/are allowed.

☒ Claim(s) 1-3, 7, 8, and 10-12 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Response to Arguments***

5 The following is in response to the amendment filed 11/5/99:

Claims 14 and 15 have been canceled by applicant.

10 An action on the merits of claims 1-13, 16-24 is contained herein below.

**35 U.S.C. 103**

15 Claims 1 - 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaillard et al. (Nucl. Acids Res. 18: 378, 1990) in view of Arbige et al. (4,927,644) or Burrows et al. (4,435,429) have been overcome through applicant's amendment and arguments therein.

20 **35 U.S.C. 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

25 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

30 Claims 1-3, 7, 8, 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

35 Use of the term "polymeric" in claim 1 is vague and indefinite. One of skill in the art would not be able to determine the metes and bounds of the invention given the number of compounds and classes thereof which constitute this term.

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**Allowable Subject Matter**

Claims 4-6, 9 and 13, 16-24 appear to contain allowable subject matter.

5

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE  
10 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO  
MONTHS of the mailing date of this final action and the advisory action is not mailed until after  
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period  
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37  
CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,  
15 however, will the statutory period for reply expire later than SIX MONTHS from the date of this  
final action.

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ENDING

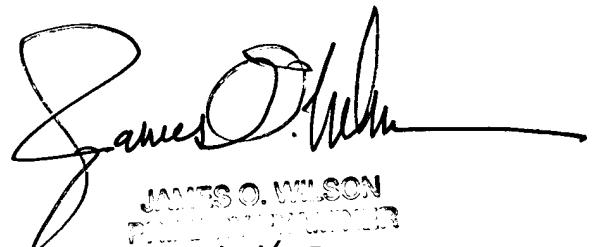
Any inquiry concerning this communication or earlier  
5 communications from the examiner should be directed to Howard Owens  
whose telephone number is (703) 306-4538 . The examiner can normally be  
reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful,  
the Primary Examiner signing this action, James O. Wilson can be reached  
10 on (703) 308-4624 . The fax phone number for this Group is (703) 308-  
4556.

Any inquiry of a general nature or relating to the status of this  
application or proceeding should be directed to the Group receptionist  
whose telephone number is (703) 308-1235.

15  
Howard Owens

Group 1623

  
JAMES O. WILSON  
FAX (703) 308-4556  
GROUP 1600